

b.) Remarks

Claims 2, 4, 13 and 15 have been amended in order to recite the present invention with the specificity required by statute. No new matter has been added.

Claims 2 and 4 (and claims 5-18, 24 and 51-53 depending therefrom) are rejected under 35 U.S.C. §112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention since the Examiner contends “represented by” can be misunderstood. Although the rejection is without basis in fact since the term is plainly conventional to those of ordinary skill<sup>1</sup>, solely in order to reduce the issues and expedite prosecution, “represented by” has been deleted from claims 2 and 4 as suggested by the Examiner. Accordingly, this rejection is mooted.

Claim 4 (and claims 5-18, 24 and 51-53 depending therefrom) is also rejected under 35 U.S.C. §112, second paragraph, since the Examiner contends the language “of a nucleotide sequence” is unclear. Although the language simply provides antecedent bases for the noted nucleotide sequences (and is similarly well-understood<sup>2</sup>), such too has been amended as suggested by the Examiner in order to expedite prosecution hereof. Accordingly, this rejection is mooted as well.

Claim 13 and 15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention since the Examiner states “medium” lacks

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<sup>1</sup> Witness the 294 patents containing “represented by SEQ ID NO” in their claims issued from 1976 to date.

<sup>2</sup> Witness the 8292 patents containing “of a nucleotide sequence represented by” in their claims issued from 1976 to date.

antecedent basis. In response, the term is deleted from claims 13 and 15. This rejection is therefore overcome.

Claim 6 is rejected because the invention appears to employ novel vectors that the Examiner wishes to ensure will be publicly available. In response, Applicants wish to respectfully point out that a Deposit Declaration regarding pBS-h FT9(S2) was filed on June 3, 2003. Moreover, regarding pAMo-mFT9, Applicants showed at pages 25-26 of their amendment of that date that such was well-known and readily reproducible by those of ordinary skill (see, e.g., *JBC*, 268, 22722 (1993) and U.S. Patent No. 5,384,249 at column 30, et seq).

Claims 2 and 4 (and claims 5-18, 24 and 51-53) are rejected under 35 U.S.C. §112, first and second paragraphs, because the claimed process is said not to be enabled using enzymes other than those of SEQ ID NOS: 1 and 2 nor, the Examiner contends, is such subject matter adequately described in the specification as filed. This rejection is respectfully traversed.

As to claim 2, which explicitly relates to SEQ ID NOS: 1 and 2, the rejection is without basis in fact. As to claim 4, subpart (h), such recites stringent hybridization conditions, (i) which is acknowledged by the Federal Circuit as being an acceptable way of describing DNA as required by 35 U.S.C. §112, second paragraph and (ii) is acknowledged as well as enabling those of ordinary skill (*Enzo Biochem, Inc. v. Gen-Probe, Inc.* 323 F.3d. 956 (Fed. Cir. 2002)) as required by 35 U.S.C. §112, first paragraph. See also, e.g., Example 9 of the Examiner's Training Manual on written description, discussing that a disclosed cDNA encoding a protein of known structure

adequately describes isolated nucleic acids that specifically hybridize to the complement under stringent conditions.

Nonetheless, subpart (h) has been amended in order to specify the complement of the noted DNA sequences, as kindly suggested by the Examiner. As to claim 4, subparts (a)-(g), the Examiner's concerns are all mooted by the above-discussed amendments.

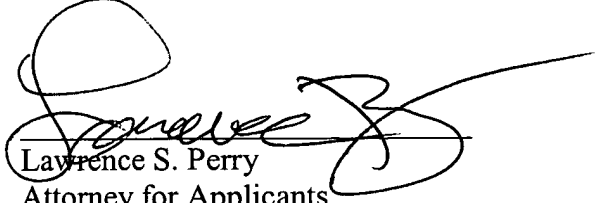
Finally, claims 2, 4-12, 17-18, 24 and 51-53 are rejected under 35 U.S.C. §102(a) as anticipated by Ge et al. (*J. Biol. Chem.*, Vol. 272 (34):21357-21363, August 1997). These claims are also rejected under 35 U.S.C. §102(b) as anticipated by Lowe et al. (*J. Biol. Chem.*, Vol. 266(26):17467-17477, September 1991). Both of these rejections are addressed as well by the foregoing amendments (see page 12, lines 2-3 of the Office Action).

In view of the above amendments and remarks, Applicants submit that all of the Examiner's concerns are now overcome and the claims are now in allowable condition. Accordingly, reconsideration and allowance of this application is earnestly solicited.

Claims 2, 4-18, 24 and 51-53 remain presented for continued prosecution.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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